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09/582,182	10/26/2000	Alfred Von Schuckmann	06275/209001	8134

7590 09/10/2003  
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EXAMINER

RADEMACHER, MARK A

ART UNIT	PAPER NUMBER
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3761

DATE MAILED: 09/10/2003

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Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/582,182

Applicant(s)

VON SCHUCKMANN ET AL.

Examiner

Mark Rademacher

Art Unit

3761

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on 16 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 28-55 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 28-55 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☒ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☒ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Priority***

1. Acknowledgment is made of applicant's claim for foreign priority based on applications filed in Germany on December 22, 1997 (DE19757207.3 and DE19757208.1). It is noted, however, that applicant did not file of the DE197208.1 application with the International Bureau, and has not filed a certified copy as required by 35 U.S.C. 119(b).

### ***Claim Objections***

2. Amended claims 28 and 48 are objected to because of the following informalities: In amended claim 28, in the indented clause beginning with "said blade". It appears that the applicants intended to recite "said cutting blade". A similar error occurs in the third indented clause beginning with "said blade". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Amended claims 28-48, 54, 55 are rejected under 35 U.S.C. 102(b) as being anticipated by international publication no. WO 96/09085 ('085 publication).

5. Among the embodiments disclosed in the '085 publication, a suction tube including all of the features recited in claims 28-47 is disclosed.

6. Generally, the suction tube disclosed includes an elongate body including a feed tube assembly (14, 18), a plume capture chamber (30) onto which a mouthpiece (32) is provided. The

Art Unit: 3761

tip of the feed tube assembly opposite the capture chamber includes an inlet section and inlet.

Opposite the inlet is an outlet portion providing the mouthpiece (32). See, e.g.; FIG 1.

7. An alternative embodiment of the feed tube assembly (14) is disclosed in FIGS 7-12C.

The alternate structure, feed tube assembly (100), includes an inlet section (108) including an inlet (end of tube 106). AS seen in FIGS 10 and 11A in particular the inlet section includes a cutting assembly having at least one cutting blade and at least one ram blade (150).

8. The cutting blade being one half of the blade structure (144). The half is made up of opposing triangular sections that taper to a point and define a blade that traverses the inlet. See, e.g., p.28, lines 27 through p. 29, line 2.

9. The ram blade (150) includes a bearing surface that is suitable for pushing the covering film of a blister into the cavity of the blister. See, e.g., 12A-12C.

10. The ram blade (150) is smaller than the cutting blade and therefore, the cutting blade extends axially forward of the bearing surface of the ram blade (150). See, e.g., FIGS 12A-12C.

11. With respect to claims 54 and 55, the '085 publication discloses the suction tube in the context of a dry powder inhaler in which the cutting assembly opens a sealed blister containing a powdered medicament. See, e.g., FIGS 12A-12C and FIG 1.

### ***Claim Rejections - 35 USC § 103***

12. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Art Unit: 3761•

13. Amended claims 28-55 are rejected under 35 U.S.C. 103(a) as being unpatentable over international publication no. WO 97/40876 (the '876 publication) in view of WO 96/09085 (the '085 publication).

14. The '876 publication discloses an inhaler that includes all of the features recited in claims 1-54 except for the cutting blade that extends across the inlet.

15. Such a cutting blade structure was known at the time of invention, however. For example, in the '085 publication a blister piercing portion is disclosed. The blister-piercing portion includes a cutting assembly (144) made up of two intersecting blades that extend across an inlet. The blister-piercing portion further includes a ram blade (150) that is adapted to push the blister cover downward after the blister is opened. See, e.g., FIGS 7-12C.

16. At the time of invention it would have been obvious to one with ordinary skill to modify the suction tube of the inhaler disclosed in the '876 publication to include the blister piercing portion disclosed in the '085 publication. One would have been motivated to do so to provide a more durable blister piercing tip as compared to the un reinforced blade design disclosed in the '085 patent for example.

### ***Double Patenting***

17. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Art Unit: 3761

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

18. Amended claims 28-55 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,520,179 to *Von Schuckmann et al.* Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 4 of the '179 patent teaches all of the features of claims 28, 48, 54 and 55.

19. Some of the specific geometric relationships of the components of the suction tube recited in the dependent claims of the present application are not expressly recited in claim 4 of the '179 patent. However these features are not patentably distinguishable from the device recited in claim 4.

20. At the time the invention was made, it would have been an obvious matter of design choice to a person of ordinary skill in the art to modify the device recited in claim 4 of the '179 patent because the applicant has not disclosed that the specific geometric relationships recited in the dependent claims provide an advantage, are used for a particular purpose or solves a stated problem not solved by the arrangement recited in claims 4. Therefore the depending claims are not patentably distinguishable from claim 4 of the '179 patent.

#### ***Response to Arguments***

21. Applicant's arguments with respect to the claims rejected in the initial action have been considered but are moot in view of the new ground(s) of rejection.

22. The claim objections raised in the initial office action are withdrawn. The rejection of claims 28-53 under section 112 is also withdrawn.

Art Unit: 3761

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mark Rademacher whose telephone number is (703) 305-0842.

The examiner can normally be reached on Monday through Friday, 9:30am - 6pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Weilun Lo can be reached on (703) 308-1957. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0858.

MAR

  
**GLENN K. DAWSON**  
**PRIMARY EXAMINER**